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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/804,526	03/18/2004	Dale E. Herman	1464-003	8397
32905	7590	08/24/2004	EXAMINER	
JONDLE & ASSOCIATES P.C. 9085 EAST MINERAL CIRCLE SUITE 200 CENTENNIAL, CO 80112			HWU, JUNE	
			ART UNIT	PAPER NUMBER
			1661	

DATE MAILED: 08/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/804,526

Applicant(s)

HERMAN ET AL.

Examiner

June Hwu

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 March 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Rule 105 requirement.

**DETAILED ACTION**

Requirement for Information follows regarding specifics of a potential public use or offer for sale.

***Rule 105 Requirements for Information***

An issue of public use or on sale activity has been raised in this application. Applicant should give evidence why the North Dakota Nursery News printed on January 24, 2001 and 2002 Annual Highlights Agriculture at North Dakota State University were not a public use or offer for sale. Applicant should point out whether the claimed plant was in public use, more than one year prior to the filing of this application by another to use the invention without restriction or obligation of secrecy (MPEP 2133.03(b)). The MPEP states:

"Public use" of a claimed invention under 35 U.S.C. 102(b) occurs when the inventor allows another person to use the invention without limitation, restriction or obligation of secrecy to the inventor." In re Smith, 714 F.2d 1127, 1134, 218 USPQ 976, 983 (Fed. Cir. 1983). The presence or absence of a confidentiality agreement is not itself determinative of the public use issue, but is one factor to be considered along with the time, place, and circumstances of the use which show the amount of control the inventor retained over the invention. *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1265, 229 USPQ 805, 809 (Fed. Cir. 1986). See *Ex parte C*, 27 USPQ2d 1492, 1499 (Bd. Pat. App. & Inter. 1992) (Inventor sold inventive soybean seeds to growers who contracted and were paid to plant the seeds to increase stock for later sale. The commercial nature of the use of the seed coupled with the "on-sale" aspects of the contract and apparent lack of confidentiality requirements rose to the level of a "public use" bar.); *Egbert v. Lippmann*, 104 U.S. 333, 336 (1881) (Public use found where inventor allowed another to use inventive corset insert, though hidden from view during use, because he did not impose an obligation of secrecy or restrictions on its use.).

Applicant should also indicate whether the claimed plant was ready for patenting, i.e. reduced to practice as in the instant plant had been asexually propagated and existed in its present form, more than one year prior to the filing date of this instant application (see MPEP 2133.03(c) I). The MPEP states:

The Invention Must Be "Ready for Patenting" at the Time of the Sale In *Pfaff v. Wells Elecs., Inc.*, 525 U.S. 55, 66-68, 119 S.Ct. 304, 311-12, 48 USPQ2d 1641, 1647 (1998), the Supreme Court enunciated a two-prong test for determining whether an invention was "on sale" within the meaning of 35 U.S.C. 102(b) even if it has not yet been reduced to practice. "[T]he on-sale bar applies when two conditions are satisfied before the critical date [more than one year before the effective filing date of the U.S. application]. First, the product must be the subject of a commercial offer for sale.... Second, the invention must be ready for patenting." *Id.* at 67, 119 S.Ct.

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at 311-12, 48 USPQ2d at 1646-47. "Ready for patenting," the second prong of the Pfaff test, "may be satisfied in at least two ways: by proof of reduction to practice before the critical date; or by proof that prior to the critical date the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention." *Id.* at 67, 199 S.Ct. at 311-12, 48 USPQ2d at 1647 (The patent was held invalid because the invention for a computer chip socket was "ready for patenting" when it was offered for sale more than one year prior to the application filing date. Even though the invention had not yet been reduced to practice, the manufacturer was able to produce the claimed computer chip sockets using the inventor's detailed drawings and specifications, and those sockets contained all elements of invention claimed in the patent.). See also *Weatherchem Corp. v. J.L. Clark Inc.*, 163 F.3d 1326, 1333, 49 USPQ2d 1001, 1006-07 (Fed. Cir. 1998) (The invention was held "ready for patenting" since the detailed drawings of plastic dispensing caps offered for sale "contained each limitation of the claims and were sufficiently specific to enable person skilled in art to practice the invention"). If the invention was actually reduced to practice before being sold or offered for sale more than 1 year before filing of the application, a patent will be barred.

In order for the examiner to properly consider patentability of the claimed invention under 35 U.S.C. 102(b), additional information regarding this issue is required as follows:

1. The relationship between North Dakota State University (NDSU) and any wholesale nurseries that may have purchased or distributed the claimed invention.
2. It is unclear if Dr. Herman offered for sale the claimed cultivar or provided information as to where to purchase the claimed plant (page 4 of North Dakota Nursery News and page 3 of 2002 Annual Highlights).
3. It is uncertain if the claimed cultivar was in public use or offered for sale at NDSU Research Arboretum near Absaraka, NDSU research extension center in Minot, Dickinson, Carrington and Langdon, urban foresters in Grand Forks, Fargo and Bismarck, North Central Regional Plant Introduction Station in Ames, Iowa, and wholesale nurseries (page 2 of 2002 Annual Highlights).
4. It is unknown if any of these research centers and nurseries had purchased the claimed cultivar for field trial, and if not, whether any secrecy agreements were made, or if any other evidence exists that indicate that the instant plant had not been released to the public.

This Office action has an attached requirement for information under 37 CFR 1.105. A complete reply to this Office action must include a complete response to the attached requirement

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for information. The time period for reply to the attached requirement coincides with the time period for reply to this Office action.

In order to consider whether a 102(b) rejection should be applied, the Examiner is requesting information pertaining to the claimed cultivar regarding the potential sale or public use in the U.S.

Applicant is reminded that failure to fully reply to this requirement for information will result in a holding of abandonment.

### **Drawings**

An Official Draftsman has approved the drawings.

### **Objection to the Disclosure**

#### **37 CFR 1.163**

The following is a quotation of section (a) of 37 CFR 1.163:

(a) The specification must contain as full and complete a disclosure as possible of the plant and the characteristics thereof that distinguish the same over related known varieties, and its antecedents, and must particularly point out where and in what manner the variety of plant has been asexually reproduced. In the case of a newly found plant, the specification must particularly point out the location and character of the area where the plant was discovered.

#### **35 USC § 112**

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

In plant application filed under 35 U.S.C. 161, the requirements of 35 U.S.C. 112 are limited.

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The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

As specific to United States Plant Patent applications, the specifics of 37 CFR 1.164

(reproduced below) are controlling:

The claim shall be in formal terms to the new and distinct variety of the specified plant as described and illustrated, and may also recite the principal distinguishing characteristics. More than one claim is not permitted.

In plant applications filed under 35 U.S.C. 161, the requirements of 35 U.S.C. are limited. The following is a quotation of 35 U.S.C. 162:

No plant patent shall be declared invalid for noncompliance with section 112 of this title if the description is as complete as is reasonably possible. The claim in the specification shall be in formal terms to the plant shown and described.

The disclosure is objected to under 37 CFR 1.163(a) because the specification presents less than a full and complete botanical description and the characteristics which distinguish over related known varieties.

More specifically:

- A. Applicants must set forth in the specification a brief description how the new variety is distinguished from its parents.
- B. Applicant must specify the name of the color chart referenced in the specification.

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C. Applicants should set forth in the specification a botanical description of the lenticels on the trunk such as average size, shape and color designation with reference to the employed color chart.

D. Paragraph [0012], the recitation "Beige" is vague and does not accurately describe the color designation with reference to the employed color chart of the lenticels.

E. Paragraph [0012], the recitation "Plentiful" is vague and does not sufficiently describe the number of lenticels per given area.

F. Applicants should set forth in the specification the shape of the branch lenticels and surface texture of the branch.

G. If available, Applicants should set forth in the specification a botanical description of the leaf buds such as size, shape, number of scales, color designation and leaf scar shape.

H. Paragraph [0013], the recitations "137A/B" and "164A/B" are unclear as to whether the Applicants intend the color(s) set forth to be a mixture of the two color designations, a color that varies between the two color designations, or if each color is individually present. Correction and/or clarification are necessary.

I. Applicants should set forth in the specification the petiole's surface texture, diameter, and color designation with reference to the employed color chart.

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J. Applicants should set forth in the specification a botanical description of the floret's size (length and diameter), flower type, petal number, and petal size.

K. Applicants should set forth in the specification the calyx's shape, average size, and color designation with reference to the employed color chart in the interest of providing as complete a botanical description of the plant as is reasonably possible.

L. If available, the applicants should set forth into the specification the lastingness, blooming period and fragrance of the bloom.

M. Applicants should set forth in the specification the reproductive organs such as number of stamens and pistils, lengths of the filaments and pistil, pollen color at least in general color terms, and color designation with reference to the employed color chart of the filaments, anthers, style and stigma in the interest of providing as complete a botanical description of the plant as is reasonably possible.

N. Paragraph [0015], the recitations "164A/B" and "165 B/C" are unclear as to whether the Applicants intend the color(s) set forth to be a mixture of the two color designations, a color that varies between the two color designations, or if each color is individually present. Correction and/or clarification are necessary.

O. Applicants should set forth in the specification the color designation with reference to the employed color chart of the immature capsule.

P. Applicants should set forth in the specification the surface texture of the capsules.



The above listing may not be complete. Applicants should carefully compare the claimed plant with the botanical descriptions set forth in the specification to ensure completeness and accuracy and to distinguish the plant within this expanding market class. Any further botanical information should be imported into the specification, as should any additional or corrected information relative to same.

### **Claim Rejection**

#### **35 USC § 112, 1st and 2nd Paragraphs**

Claim 1 is rejected under 35 U.S.C. 112, first and second paragraphs as not being supported by a clear and complete botanical description of the plant for reasons set forth in the Objection to the Disclosure Section above.

### **Future Correspondence**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to June Hwu whose telephone number is (571) 272-0977. The Examiner can normally be reached Monday through Thursday from 6:30 a.m. to 5:00 p.m.

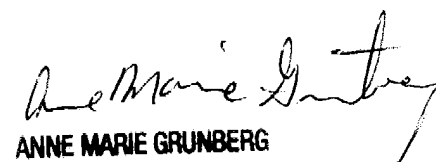
If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax number for the organization where this application or proceeding is assigned is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR

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system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JH

  
ANNE MARIE GRUNBERG  
PRIMARY EXAMINER

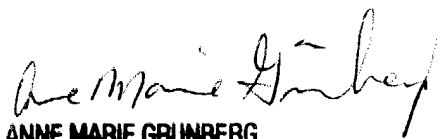
**REQUIREMENT FOR INFORMATION UNDER 37 CFR 1.105**

Applicants and the assignee of this application are required under 37 CFR 1.105 to provide the previous information starting on page 2 of the Office Action that the examiner has determined is reasonably necessary to the examination of this application.

The information is required to clearly explain if the claimed plant was in public use or offered for sale prior to the effective filing date of the instant application.

The fee and certification requirements of 37 CFR 1.97 are waived for those documents submitted in reply to this requirement. This waiver extends only to those documents within the scope of this requirement under 37 CFR 1.105 that are included in the applicant's first complete communication responding to this requirement. Any supplemental replies subsequent to the first communication responding to this requirement and any information disclosures beyond the scope of this requirement under 37 CFR 1.105 are subject to the fee and certification requirements of 37 CFR 1.97.

This requirement is an attachment of the enclosed Office action. A complete reply to the enclosed Office action must include a complete response to this requirement. The time period for reply to this requirement coincides with the time period for reply to the enclosed Office action, which is 3 months.

  
**ANNE MARIE GRUNBERG**  
**PRIMARY EXAMINER**